

REMARKS

The Board of Appeals has affirmed the rejection of Claims 1-8 and 10-31 under 35 U.S.C. 103(a) as being unpatentable over Aronson et al. (U.S. Patent No. 6,654,787 B1), in view of Leeds (U.S. Patent No. 6,393,465 B2). Additionally, the Board of Appeals has entered new grounds of rejection for Claims 1-8 and 10-31. Specifically, the Board of Appeals has rejected Claims 1-8, 10-12, and 22-31 under 35 U.S.C. 101 as being directed toward non-statutory subject matter. Additionally, the Board of Appeals has rejected Claims 13-21 under 35 U.S.C. 112, first paragraph, for lack of an enabling disclosure commensurate with the claim scope.

In response to the new grounds of rejection under 35 U.S.C. 101 and under 35 U.S.C. 112, first paragraph, applicant respectfully asserts that such rejections have been overcome by virtue of the amendments made hereinabove to the independent claims.

Furthermore, with respect to the rejection of Claims 1-8, 10-12, and 27-31 under 35 U.S.C. 101, applicant respectfully notes that “[a] claimed process is surely patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing,” where the transformed articles may include “physical objects or substances” or articles “representative of physical objects or substances.” *In re Bilski*, 545 F.3d 943, 954 & 963 (Fed. Cir. 2008)

In the present case, applicant claims “collect[ing] threat information” and “report[ing] to the hosting authority” (see independent Claim 1, as amended - emphasis added), as claimed, which is a “transformation” and is clearly statutory. By virtue of the claimed “collect[ing]” and “report[ing],” as claimed, applicant clearly teaches and claims a “transformation” of a physical object or substance, or an article representative of a physical object or substance, to a different state or thing.

For these and various other reasons, applicant respectfully contends that the claims at issue are clearly statutory and meet the requirements of 35 U.S.C. 101.

Additionally, in response to the affirmation of the rejections under 35 U.S.C. 103(a), applicant has amended the independent claims to further distinguish applicant's claim language from the relevant references relied upon by the Examiner.

Specifically, applicant has amended the independent claims to further distinguish applicant's claim language from the relevant references relied upon by the Examiner, as follows:

“transmitting the report to a central managed service provider, where the central managed service provider collects threat information from one or more organizations and reports to the hosting authority once a predetermined amount of threat information has been collected” (see this or similar, but not necessarily identical language in the independent claims).

With respect to the above subject matter now incorporated into the independent claims, applicant respectfully asserts that Leeds simply teaches that “addresses could be watched for incoming junk e-mail and a notification from the authentication server could then be broadcast to users indicating that mail with the subject of ‘XYZ is junk e-mail” (Col. 8, lines 47-50).

However, merely broadcasting a notification of junk mail to users, as in Leeds, fails to teach “transmitting the report to a central managed service provider, where the central managed service provider collects threat information from one or more organizations and reports to the hosting authority once a predetermined amount of threat information has been collected” (emphasis added), as specifically claimed by applicant.

Additionally, applicant notes that Aronson merely discloses that “[an] e-mail message recipient is sent a notification by the server indicating that messages have been filtered” (Abstract). However, merely sending a message recipient a notification that messages have been filtered, as in Aronson, fails to teach “transmitting the report to a

central managed service provider, where the central managed service provider collects threat information from one or more organizations and reports to the hosting authority once a predetermined amount of threat information has been collected" (emphasis added), as specifically claimed by applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Thus, a notice of allowance or a proper prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

To this end, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P314).

Respectfully submitted,
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